



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPEAL BRIEF

Inventors : Terry L. Oehrke
 Serial No. : 09/594,070
 Filing Date : June 14, 2000
 Title : COMPUTER NETWORK METHOD AND SYSTEM
 FOR GUARANTEED MESSAGING SERVICE

Group/Art Unit : 2144
 Examiner : Michael A. Delgado

Docket No. : 1234

Mail Stop Appeal Brief – Patent
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Applicant submits this
 Appeal Brief in support of the Notice of Appeal filed on October 13, 2004.

I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is the assignee, Sprint
 Communications Company, L.P. The assignment was recorded at Reel 011258, Frame 0478 of
 the U.S. Patent and Trademark Office records.

Certificate of Mailing Under 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the
 United States Postal Service with sufficient postage as first class mail
 in an envelope addressed to Mail Stop Appeal Brief – Patent,
 Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-
 1450, on:

Date: 12-13-2004

Signature: Donna Oakley

Printed Name: Donna Oakley

The Director is hereby authorized to charge
 any additional amount required, or credit any
 overpayment, to Deposit Account No.
 19-4409.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-19 are pending in the application. Claims 1-19 stand finally rejected, as follows: claims 1-4, 7-12 and 15-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No. 6,047,331 to Medard *et al.*; and claims 5-6 and 13-14 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No. 6,047,331 to Medard *et al.*, and further in view of U.S. Patent No. 6,130,875 to Doshi *et al.* The present appeal is directed to claims 1-19, which are reproduced in Appendix A attached hereto.

IV. STATUS OF AMENDMENTS

In response to the final rejection set forth in the Office Action dated April 13, 2004, Applicant filed an Amendment and Response to Office Action on June 14, 2004 that included a proposed amendment to claim 1 of the application. In the Advisory Action dated October 8, 2004, the Examiner indicated that such amendment would not be entered for purposes of the present appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to a method and computer network for providing a reliable messaging service on a computer network, such as that used for routing e-mail

messages over the Internet, so that a message will not be lost when the messaging server (*i.e.*, the intended destination for the message) becomes non-operational.

Independent claim 1 (and thus dependent claims 2-8) is directed to the method of the present invention and will be described with reference to FIGS. 1 and 2. In accordance with the method, a message is routed to a messaging server 14 on the network 10 (*i.e.*, the intended destination for the message). When the message is undeliverable to the messaging server 14 (such as when the messaging server 14 is not operational), the message is provided to a relay server 16 on the network 10. Then, when the messaging server 14 is operational, the message is re-routed from the relay server 16 to the messaging server 14 so that the message may reach its intended destination.¹

Independent claim 9 (and thus dependent claims 10-19) is directed to the computer network of the present invention and will be described with reference to FIG. 1. The computer network 10 includes a Domain Name System (DNS) server 12, a messaging server 14, and a relay server 16 operably connected to the DNS server 12 and the messaging server 14. The DNS server 12 is operable to route a message to the messaging server 14 (*i.e.*, the intended destination for the message). The DNS server 12 is also operable to provide the message to the relay server 16 when the messaging server 14 is inoperable such that the message is undeliverable to the messaging server 14. The relay server 16 is then operable to re-route the

¹/ The subject matter of claims 1-8 is described on page 6, line 12 to page 8, line 10 of the application.

message from the relay server 16 to the messaging server 14 when the messaging server 14 is operational so that the message may reach its intended destination.²

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

1. Whether claims 1-4, 7-12 and 15-19 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No. 6,047,331 to Medard *et al.*; and
2. Whether claims 5-6 and 13-14 are unpatentable under 35 U.S.C. §103 (a) as being obvious over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No. 6,047,331 to Medard *et al.*, and further in view of U.S. Patent No. 6,130,875 to Doshi *et al.*

VII. ARGUMENT

A. Applicant's Claims are not Obvious Over McDowell in View of Medard

The Examiner has rejected claims 1-4, 7-12 and 15-19 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,438,583 to McDowell *et al.* ("McDowell") in view of U.S. Patent No. 6,047,331 to Medard *et al.* ("Medard").

McDowell (attached hereto as Appendix B) discloses a system that addresses the problems that occur when a user switches from a first Internet Service Provider (ISP) to a second ISP but continues to receive e-mail messages sent to the first ISP. In the McDowell system, an e-mail message sent to the first ISP is: (1) received by the first ISP; (2) identified as belonging

²/ The subject matter of claims 9-19 is described on page 4, line 4 to page 6, line 11 of the application.

to a former subscriber of the first ISP; and then (3) forwarded directly from the first ISP to the second ISP, or, forwarded from the first ISP to a re-route server which in turn forwards the message to the second ISP.³ Thus, in the McDowell system, the e-mail message is successfully received by the first ISP before it is forwarded to the second ISP (either directly or via the re-route server).

Medard (attached hereto as Appendix C) discloses a method for implementing automatic protection switching in communication or power networks. As shown in FIG. 1 of Medard, the network includes a plurality of nodes 12a-12e that are connected to each other via a plurality of links 20a-20h.⁴ Each of the nodes 12a-12e includes a routing table 16 that stores a primary path and a secondary path for each source node/destination node pair in the network.⁵ In operation, if a link or node becomes inoperable so as to disrupt the primary path between a source node and a destination node, the system will use the secondary path to avoid the inoperable link or node.⁶ Thus, Medard teaches a method of circumventing an inoperable link or node in order to route signals from a source node to a destination node.

1. **Claims 1-4 and 7-8**

Applicant respectfully submits that a *prima facie* case of obviousness for rejecting claims 1-4 and 7-8 has not been established in that McDowell and Medard do not alone or in combination disclose or suggest the claimed invention. *See In re Bell*, 26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting *In re Rinehart*, 189 U.S.P.Q. 143,147 (C.C.P.A. 1976)) (finding

³/ *See* McDowell at column 3, line 64 to column 7, line 49; column 8, line 14 to column 13, line 41.

⁴/ *See* Medard at column 9, lines 18-43.

⁵/ *See* Medard at column 9, line 44 to column 10, line 18.

⁶/ *See* Medard at column 10, lines 19-41.

that the Patent Office's burden of establishing a *prima facie* case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.").

Specifically, McDowell does not disclose or suggest the steps of routing a message to a messaging server, providing the message to a relay server when the message is undeliverable to the messaging server, and then re-routing the message from the relay server to the messaging server when the messaging server is operational, as required by claims 1-4 and 7-8.

As discussed above, McDowell discloses a system that routes an e-mail message to a first ISP and then forwards the message from the first ISP to a second ISP (either directly or via a re-route server). The McDowell system does *not* disclose the limitation underlined above, namely, re-routing a message from a relay server back to a messaging server (*i.e.*, the first ISP). In fact, McDowell teaches against this limitation in that the primary purpose behind the McDowell system is to forward an e-mail message from a first ISP to a second ISP (*not* back to the first ISP) when a user switches from the first ISP to the second ISP.

Furthermore, McDowell does *not* teach re-routing the message back to the first ISP when the first ISP is "operational." In fact, if the first ISP of the McDowell system were not "operational," it would not be able to receive an e-mail message and, thus, would not be able to identify the intended recipient of the message as a former subscriber and would not be able to forward the message to the second ISP. Instead, the McDowell system would simply lose the e-mail message sent to the inoperable first ISP such that the message would be undeliverable to the intended recipient.

Medard also does not disclose or suggest the steps of routing a message to a messaging server, providing the message to a relay server when the message is undeliverable to the messaging server, and then re-routing the message from the relay server to the messaging server when the messaging server is operational, as required by claims 1-4 and 7-8. As discussed above, Medard discloses a method for routing signals from a source node to a destination node over a secondary path when a link or node in the primary path fails. Medard does *not* disclose the limitation underlined above, namely, re-routing a message from a relay server to a messaging server when the messaging server is “operational.” In other words, Medard does *not* disclose the re-routing of signals to a different node when the destination node is not “operational”. Rather, Medard merely discloses the routing of signals over a secondary path to the destination node so as to avoid the failed link or node in the primary path.

Furthermore, the combination of McDowell and Medard does not disclose or suggest the claimed invention. Indeed, if these references were combined, the result would be a system that forwards an e-mail message from a first ISP to a second ISP (as taught by McDowell) over a network that uses automatic protection switching (as taught by Medard). This combination would *not*, however, result in the steps of routing a message to a messaging server, providing the message to a relay server when the message is undeliverable to the messaging server, and then re-routing the message from the relay server to the messaging server when the messaging server is operational.

Because the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness, claims 1-4 and 7-8 should be allowed.

2. Claims 9-12 and 15-19

Applicant also respectfully submits that a *prima facie* case of obviousness for rejecting claims 9-12 and 15-19 has not been established in that McDowell and Medard do not alone or in combination disclose or suggest the claimed invention. *See In re Bell*, 26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting *In re Rinehart*, 189 U.S.P.Q. 143,147 (C.C.P.A. 1976)) (finding that the Patent Office's burden of establishing a *prima facie* case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.").

Specifically, McDowell does not disclose or suggest a computer network comprising a messaging server, a DNS server operable to route a message to the messaging server, and a relay server operably connected to the DNS server and the messaging server, wherein (1) the DNS server is operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server, and (2) the relay server is operable to re-route the message from the relay server to the messaging server when operational, as required by claims 9-12 and 15-19.

As discussed above with respect to claims 1-4 and 7-8, McDowell does not disclose the second limitation underlined above. Furthermore, McDowell does not disclose the first limitation underlined above, namely, a DNS server that is operable to provide a message to a relay server when the messaging server is "inoperable" such that the message is "undeliverable" to the messaging server. Rather, McDowell discloses a system that routes an e-mail message to an *operable* first ISP and then forwards the message from the *operable* first ISP to an *operable* second ISP. The message is forwarded because the first ISP address is no longer active, *not* because the first ISP is "inoperable" such that the message is "undeliverable" to the first ISP. As

discussed above, if the first ISP of the McDowell system were “inoperable,” it would not be able to receive an e-mail message and, thus, would not be able to identify the intended recipient of the message as a former subscriber and would not be able to forward the message to the second ISP. Instead, the McDowell system would simply lose the e-mail message sent to the inoperable first ISP such that the message would be undeliverable to the intended recipient.

By contrast, claims 9-12 and 15-19 are directed to a system in which a message sent to a messaging server that is *inoperable* is provided to a relay server which re-routes the message to that *same messaging server* when that messaging server is operable and can receive the message. Thus, a message sent to an *inoperable* messaging server will *not* simply be lost, as would happen in the McDowell system. Instead, the undeliverable message is provided to a relay server which serves to store the message until the messaging server becomes operable at which time the relay server can re-route the message to the now-operable messaging server.

Medard also does not disclose or suggest a computer network comprising a messaging server, a DNS server operable to route a message to the messaging server, and a relay server operably connected to the DNS server and the messaging server, wherein (1) the DNS server is operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server, and (2) the relay server is operable to re-route the message from the relay server to the messaging server when operational, as required by claims 9-12 and 15-19.

As discussed above with respect to claims 1-4 and 7-8, Medard does not disclose the second limitation underlined above. Furthermore, Medard does not disclose the first limitation underlined above, namely, a DNS server that is operable to provide a message to a relay server when the messaging server is “inoperable” such that the message is “undeliverable”

to the messaging server. Rather, Medard discloses a method for routing signals from an *operable* source node to an *operable* destination node over a secondary path so as to avoid a failed link or node in a primary path). Unlike Medard, the system of claims 9-12 and 15-19 does not re-route a message to a final destination along a different path in order to *avoid* a failed link or node. Instead, the inoperable messaging server in the present application *is* the final destination. In fact, any message sent to an inoperable destination node in Medard would be lost.

Furthermore, the combination of McDowell and Medard does not disclose or suggest the claimed invention. Indeed, if these references were combined, the result would be a system that forwards an e-mail message from an *operable* first ISP to an *operable* second ISP (as taught by McDowell) over a network that uses automatic protection switching (as taught by Medard). This combination would *not*, however, result in a computer network comprising a messaging server, a DNS server operable to route a message to the messaging server, and a relay server operably connected to the DNS server and the messaging server, wherein (1) the DNS server is operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server, and (2) the relay server is operable to re-route the message from the relay server to the messaging server when operational, as required by claims 9-12 and 15-19.

Because the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness, claims 9-12 and 15-19 should be allowed.

B. Applicant's Claims are not Obvious Over McDowell in View of Medard and Doshi

The Examiner has also rejected dependent claims 5-6 and 13-14 (which depend from independent claims 1 and 9, respectively) under 35 U.S.C. § 103(a) as being obvious over

McDowell in view of Medard, and further in view of U.S. Patent No. 6,130,875 to Doshi *et al.* (attached hereto as Appendix C). These dependent claims incorporate all of the limitations of the independent claims from which they depend. Thus, for the reasons discussed above with respect to independent claims 1 and 9, Applicant respectfully submits that claims 5-6 and 13-14 should be allowed.

VIII. APPENDICES

Attached hereto are the following Appendices:

Appendix A – Claims on Appeal

Appendix B – U.S. Patent No. 6,438,583 to McDowell *et al.*

Appendix C – U.S. Patent No. 6,047,331 to Medard *et al.*

Appendix D – U.S. Patent No. 6,130,875 to Doshi *et al.*

IX. SUMMARY

For the foregoing reasons, Applicant respectfully submits that claims 1-19 are patentable over the cited references and should be allowed. Accordingly, Applicant respectfully requests that the Board reverse the Examiner's rejections and allow claims 1-19.

Respectfully submitted,

By: Judith L. Carlson, J.A.S.
Judith L. Carlson, Reg. No. 41,904
STINSON MORRISON HECKER LLP
1201 Walnut Street, Suite 2900
P.O. Box 419251
Kansas City, MO 64141-6251
Telephone: (816) 842-8600
Facsimile: (816) 691-3495



APPENDIX A

Claims on Appeal

1. A method for providing a messaging service on a computer network, the method comprising the steps of:

- (a) routing a message to a messaging server;
- (b) providing the message to a relay server when the message is undeliverable to the messaging server; and
- (c) re-routing the message from the relay server to the messaging server when operational.

2. The method of Claim 1 further comprising:

- (d) invoking another messaging server when the message is undeliverable to the messaging server in step (c).

3. The method of Claim 2 further comprising:

- (e) routing the message to the other messaging server of step (d).

4. The method of Claim 3:

 further comprising (f) storing the message; and

 wherein step (e) comprises changing server information of the stored message.

5. The method of Claim 1 wherein step (c) comprises periodically attempting delivery of the message from the relay server to the messaging server.

6. The method of Claim 5 further comprising:

(d) invoking another messaging server when the message is undeliverable to the messaging server in step (c).

7. The method of Claim 1 further comprising:

(d) sending the message to the messaging server in response to step (c).

8. The method of Claim 3 further comprising:

(f) sending the message to the other messaging server in response to step (e).

9. A computer network for providing a messaging service, the network comprising:
a messaging server;
a DNS server operable to route a message to the messaging server; and
a relay server operably connected to the DNS server and the messaging server, the
DNS server operable to provide the message to the relay server when the messaging server is
inoperable such that the message is undeliverable to the messaging server;
wherein the relay server is operable to re-route the message from the relay server
to the messaging server when operational.

10. The network of Claim 9 further comprising:

another messaging server, the other messaging server invoked by the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to the re-routing.

11. The network of Claim 10 wherein the relay server is operable to route the

message to the other messaging server.

12. The network of Claim 11 further comprising:

a storage device operably connected to the relay server and the other messaging server, the message being stored in the storage device; and
wherein the relay server is operable to change server information of the stored message to route the message to the other messaging server.

13. The network of Claim 9 wherein the relay server is operable to periodically

attempt delivery of the message from the relay server to the messaging server.

14. The network of Claim 13 wherein the relay server is operable to invoke a process

to create another messaging server when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to the re-routing.

15. The network of Claim 9 wherein the relay server is operable to send the message

to the messaging server in response to the re-routing.

16. The network of Claim 11 wherein the relay server is operable to send the message to the other messaging server in response to routing the message to the other messaging server.

17. The network of Claim 9 wherein the messaging server and the relay server are within a first data center.

18. The network of Claim 10 wherein the messaging server and the other messaging server are in first and second data centers, the first data center remote from the second data center.

19. The network of Claim 9 wherein the relay server is operable to invoke a process to create another messaging server with a same name and IP address.

Serial No.: 09/594,070
Docket No.: 1234

APPENDIX B

U.S. Patent No. 6,438,583 to McDowell *et al.*



Serial No.: 09/954,070

Docket No.: 1234

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

TRANSMITTAL LETTER

Inventors : Terry L. Oehrke.
Serial No. : 09/594,070
Filing Date : June 14, 2000
Title : COMPUTER NETWORK METHOD AND SYSTEM
FOR GUARANTEED MESSAGING SERVICE
Group/Art Unit : 2144
Examiner : Michael A. Delgado
Docket No. : 1234

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant submits herewith, Appellant's Appeal Brief under 37 C.F.R. § 1.192 in support of the Notice of Appeal filed on October 13, 2004. Enclosed is a check in the amount of \$500.00 to cover the large entity fee for filing the Appeal Brief. A duplicate copy of this Transmittal Letter is also enclosed.

Acknowledgment of receipt is respectfully requested.

Respectfully submitted,

By: 
Judith E. Carlson, Reg. No. 41,904
STINSON MORRISON HECKER LLP
1201 Walnut Street, Suite 2800
P.O. Box 419251
Kansas City, MO 64141-6251
Telephone: (816) 842-8600
Facsimile: (816) 691-3495

Certificate of Mailing Under 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:

Date: 12-13-2004
Signature: Donna Oakley
Printed Name: Donna Oakley

The Director is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.